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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,472	05/31/2001	Toshiaki Saito	862.C2249	7632

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NEW YORK, NY 10112

EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/867,472	Applicant(s) SAITO, TOSHIAKI	
	Examiner Jerome Grant II	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>             Paper No(s)/Mail Date ____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>             Paper No(s)/Mail Date. ____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: ____.</p> |
|--|---|

**JEROME GRANT II**  
**PRIMARY EXAMINER**

### Detailed Action

1. Rejection Under Section 112

Claims 2-11 and 16-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to an apparatus but recites steps as if it is a method claim or recites a method claim with apparatus limitations, for example.

The category of the invention cannot be ascertained.

2.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-11 and 16-21 are rejected under 35 U.S.C. 101 because of the reasons recited in the 112 rejection above.

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3.

Claims 2 and 11 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 12 and 15 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 12-14 and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Akimoto.

With respect to claim 1, Akimoto teaches a communication apparatus shown by figure 1, comprising: an image processor 1-4, arranged to process color and monochrome images (see col. 3, lines 49-55 and col. 6, lines 50-60); a

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communication controller NCU 1-6 in combination with CPU 1-1 arranged to control a communication with a partner apparatus, and to select whether transmission of a color image is to be canceled (if no communication is desired) or the color image is to be sent as a monochrome image (based on a detection of DIS value, see col. 6, lines 59-65. and it is determined based on information that pertains to color reception performance of the partner apparatus that the partner apparatus does not have color reception performance. Note this limitation is addressed by the determination based upon the detection of the DIS data which reveals if the partner has color or monochrome.

With respect to claims 2 and 12, Akimoto teaches a communication apparatus comprising: an image processor (modem 1-5 and processor 1-4 to processor color and monochrome images; a communication controller NCU 1-6 arranged to control a communication with the partner apparatus; and a setter (CPU 1-1) arranged to set a transmission in accordance with the partner being able to process color, wherein the transmission of color image is instructed via NCU 1-6 and CPU 1-1 as claimed. See also col. 6, lines 59-65.

With respect to claim 3, Akimoto teaches wherein a user can set (via color key 2-6) using the setter if the color image is to be sent as a monochrome image when color cannot be performed. See col. 6, lines 15-25.

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With respect to claim 13, See col. 9, lines 30-45 where images that can't be received in color are canceled. See also col. 9, lines 15-25 where a stop key cancels transmission when the partner destination is not color capable.

With respect to claim 14, see col. 9, lines 30-40 for the setter invalidating a color transmission so that a monochrome transmission may be generated.

With respect to claim 16, Akimoto teaches a control method of controlling a communication apparatus (see figure 1) having an image processor 1-4 which processes color and monochrome images and a controller 1-6 comprising the steps of: selecting whether the transmission of the color is to be canceled or sent as a monochrome based on partner information. See col. 9, lines 30-45 where images that can't be received in color are canceled. See also col. 9, lines 15-25 where a stop key cancels transmission when the partner destination is not color capable. See col. 9, lines 30-40 for the setter invalidating a color transmission so that a monochrome transmission may be generated.

With respect to claim 17, Akimoto teaches a communication apparatus, see figure 1, having an image processor/modem 1-5 and processor 1-4; a communication controller 1-6 and a setter 1-1 as claimed comprising the steps of: controlling via 1-4 and 1-1 when transmission of a color image is instructed,

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see col. 6, lines 47-50 and 59-65, transmission of an image in accordance with information that pertains to the color reception performance of the partner apparatus and is obtained from the communication controller.

With respect to claim 18, Akimoto teaches a communication apparatus having an image processor 1-4, a communication controller 1-6 and setter CPU 1-1 comprising: controlling via CPU 1-1 and NCU 1-6 a color image transmission in accordance with the reception of a DIS signal by the modem and a signal by a setter (CPU 1-1) arranged to set a transmission in accordance with the partner being able to process color, wherein the transmission of color image is instructed via NCU 1-6 and CPU 1-1 as claimed. See also col. 6, lines 59-65.

With respect to claim 19, Akimoto teaches a computer program product (see figure 1) comprising a readable medium (RAM 1-3 having a computer program code (inherently stored in the RAM) as claimed comprising: selecting whether the transmission of the color is to be canceled or sent as a monochrome a based on partner information. , See col. 9, lines 30-45 where images that can't be received in color are canceled. See also col. 9, lines 15-25 where a stop key cancels transmission when the partner destination is not color capable. See col. 9, lines 30-40 for the setter invalidating a color transmission so that a monochrome transmission may be generated.

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With respect to claims 20 and 21, Akimoto teaches a computer product (see figure 1) with a computer readable medium (RAM 1-3) having an inherent computer code for a image processor 1-4, a setter 1-1 and a controller 1-6 as claimed, comprising: controlling via CPU 1-1 and NCU 1-6 a color image transmission in accordance with the reception of a DIS signal by the modem and a signal by a setter (CPU 1-1) arranged to set a transmission in accordance with the partner being able to process color, wherein the transmission of color image is instructed via NCU 1-6 and CPU 1-1 as claimed. See also col. 6, lines 59-65.

5.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akimoto.

While Akimoto does not specifically state that the number of color and monochrome images are counted, this limitation is at least suggested in the reference.



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This claim limitation is obvious over Akimoto in view of the fact that color and monochrome images are stored. See col. 7, lines 1-6. Once stored the number of memory space commensurate with the number of pages can be ascertained. Hence, it would have been obvious to count the number of color and monochrome images once they have been stored such that the storage space is correlated with the size of the page of the image to be printed.

**6. Claims Objected to as Containing Allowable Matter**

Claims 4-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, and Sect. 101 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

**7.**

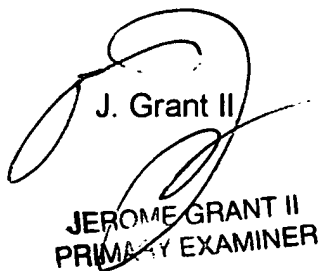
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is

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703-305-4391. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams, can be reached on 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
J. Grant II  
JEROME GRANT II  
PRIMARY EXAMINER